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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,957

11/17/2003

Jiro Moriyama

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12/18/2007

CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION
15975 ALTON PARKWAY
IRVINE, CA 92618-3731

EXAMINER

GARCIA JR, RENE

ART UNIT

PAPER NUMBER

2853

MAIL DATE

DELIVERY MODE

12/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/715,957	Applicant(s) MORIYAMA ET AL.	
	Examiner Rene Garcia, Jr.	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 14, 15, 17-19, 21-23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9, 14, 15, 17-19, 21, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 October 2007 has been entered.

Claim Objections

2. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Amendment to independent claim 14 now includes the limitations of dependent claim 7 and thus fails to further define the apparatus of independent claim 14.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 8, 9, 14, 15, 17, 18, 19, 21, 22, 23, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US PGPUB 2002/0080396) in view of Tan et al. (US 6,613,403) and Brouhon et al. (US 6,962,450).

Silverbrook et al. disclose the following:

*regarding claims 7, 14, 15, 19, 23, recording apparatus **/netpage printer, 601/** (fig. 11) and method for forming an image on a recording medium/**netpage, 1/** (fig. 1; paragraph 0216 see also paragraphs 0148 and 0218), comprising:

*recording unit/**print engine controllers, 760/** (fig. 14; paragraph 0554) for performing recording by applying a recording material/**ink/** (paragraph 0243) onto the recording medium/**1/** (fig. 1), the recording unit/**760/** recording the image/**graphic data, 2/** (fig. 1; paragraph 0129) and at least one of a positional information image/**coded data, 3/** representing positional information (paragraph 0158; x & y coordinates) corresponding to the position where the positional information image/**coded data, 3/** is recorded, wherein the positional information image/**coded data, 3/** (fig. 1) is expressed by a combination pattern of a plurality of spots to represent the positional information (figs. 6a, 6b & 6c)

*control unit/**processor, 750/** (fig. 14; paragraphs 0552 & 0553) for controlling the recording (paragraph 0220) such that the recording unit/**760/** records the positional information image with a recording material/**infrared inks, IR-absorptive black ink/** capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), and records the image with another recording material/**inks/** (paragraph 0243; cyan, magenta, yellow, black) incapable of being detected by the detector/**netpage pen, 101/** (paragraph 0151 – cyan, magenta, yellow, black are non-infrared emitting)

*wherein the recording material/**infrared inks, IR-absorptive black ink/** used for recording the positional information image/**coded data, 3/** contains carbon (paragraphs 0584 – 0592; infrared dyes/**ink/** contain carbon atoms)

*regarding claims 8, 17, 21, 25, positional information/**coded data, 3/** is associated with coordinates on the recording medium/**netpage, 1/** (fig. 1; paragraph 0159; x & y coordinates)

*regarding claims 9, 18, 22, 26, positional information/**coded data, 3/** is associated with coordinates on a virtual plane beyond the area of the recording medium/**netpage, 1/** (fig. 1; paragraph 0149; multiple pages can have same positional data & each page has unique page ID since recording medium is considered to be one page; paragraph 0157 – region to which a tag [tag ID – positional information] refers can be an arbitrary subregion of a page or other surface [virtual plane])

Silverbrook et al. does not disclose the following claimed limitations:

*regarding claims 14, 15, 19, 23, combination pattern of a plurality of spots, provided at intervals of 0.3mm

*recording material used for recording the image is a carbon-free yellow, a carbon-free magenta, a carbon-free cyan and a carbon-free black

*Silverbrook et al. does teach utilize color inks however does not expressly specify which recording material composition to utilize

Brouhon et al. discloses the following:

*regarding claims 14, 15, 19, 23, combination pattern of a plurality of spots, provided at intervals of 0.3mm (fig. 2; col. 5, lines 22-45; background information - col. 1, lines 21-39, lines 51-56, lines 61-67, col. 2, lines 1-11)

Silverbrook et al. and Brouhon et al. are analogous art because they are directed to a

similar problem solving area of position identifying patterns utilized in conjunction with a primary image.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a combination pattern of a plurality of spots, provided at intervals of 0.3mm as taught by Brouhon et al. into Silverbrook et al. for the purpose position identifying of a secondary image.

Tan et al. discloses the following:

*regarding claims 14, 15, 19, 23, recording material used for recording the image is a carbon-free yellow, a carbon-free magenta, a carbon-free cyan and a carbon-free black (col. 9, lines 10-24, particularly line 20) for the purpose of ink detection and lack of detection based on specific properties (infrared detection).

Silverbrook et al. and Tan et al. are analogous art because they are directed to a similar problem solving area of recording material/~~ink~~/ detection and recording material lack of detection.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a recording material used for recording the image is a carbon-free yellow, a carbon-free magenta, a carbon-free cyan and a carbon-free black as taught by Tan et al. into Silverbrook et al. for the purpose of ink detection and lack of detection based on specific properties (infrared detection).

Response to Arguments

5. Applicant's arguments with respect to claims 14, 15, 19, 23 have been considered but are moot in view of the new ground(s) of rejection. Silverbrook et al. modified by Tan et al. and

Brouhon et al. teaches the claimed limitations as amended and filed on 10 August 2007.

Specifically Brouhon et al. teaches the newly recited claim limitations regarding the interval of spots being 0.3mm.

6. Unrelated to prosecution of the case, it should be noted that the headers on every page of the amendments to the claims and remarks/arguments provide incorrect application number of 10/715,937.

Conclusion

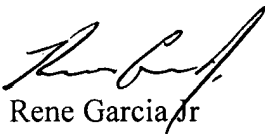
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Olsson et al. (US 6,732,927) and Fåhraeus (US 6,502,756) teach utilizing coded data and positioning information with regards to a primary image and secondary image and are cited to provide further background in the art as related to the invention.

Communication with the USPTO

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rene Garcia Jr
12/07


STEPHEN MEIER
SUPERVISORY PATENT EXAMINER